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09/728,546	12/04/2000	Brian J. Green	S215-3PCIP	5165

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EXAMINER

SLITERIS, JOSELYNN Y

ART UNIT

PAPER NUMBER

3616

DATE MAILED: 05/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,546

Applicant(s)

GREEN ET AL.

Examiner

Joselynn Y. Sliteris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 9, 10, 14, 15, 17, 33, 34, 36-40 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 11-13, 16, 18-29, 32, 41 and 42 is/are rejected.
- 7) ☒ Claim(s) 30, 31 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the embodiment of Figs. 1 through 5 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the embodiments are so closely related to each other that they should be maintained in the same application to preserve unity of invention and avoid the unnecessary expense of filing separate applications. This is not found persuasive because the burden on the examiner still exists to search, locate, and apply art to all species identified.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 5-7, 9, 10, 14, 15, 17, 33, 34, 36-40, and 43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Currently, there are no generic claims.

3. An action on the merits follows:

Priority

4. The current status of all nonprovisional parent applications referenced should be included.

Oath/Declaration

5. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The current status of the parent application (Serial No. 09/210,464 filed 12/12/98 & 09/580,042 filed 5/26/00) for which domestic priority is being claimed needs to be updated.

Drawings

✓ 6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show openings 98 (Fig. 2); the second pin opening 21 on the front and rear shock absorbing means (Fig. 7); and openings 91 (Figs. 10) as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because:

✓ - they include the following reference sign(s) not mentioned in the description: 64 (Fig. 8), 83 (Fig. 9), and 55 (Fig. 10). Correction is required. ✓

- they do not include the following reference sign(s) mentioned in the description: 50A (page 17 line 17). Correction is required.

8. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

✓ 10. Claims 1-4, 8, 11-13, 16, 18-25, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with indefinite language failing to positively set forth structure and its interconnection. Please note, here are a few examples:

✓ 11. Regarding claims 1, 4, and 18, the phrase "of the type" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "of the type"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

✓ 12. Regarding claim 13, the recitation "said wheel support means" in line 2 lacks proper antecedent basis in the claim.

✓ 13. Claim 42 is inconsistent with the elected embodiment of Figs. 1-5; therefore, claim 42 is rendered indefinite. Further, claims 8, 11, and 12 are dependent on non-elected claims; therefore, claims 8, 11, and 12 are rendered indefinite. Note, claims 8, 11, 12, and 42 were identified as readable on the elected embodiment in Paper No. 6.

Appropriate correction is required, and the claims should be reviewed in their entirety for compliance with 35 U.S.C. 112.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

15. Claims 1-4, 13, 16, 18, and 21-25, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Chen (U.S. Patent 5,690,344), as cited by Applicant.

16. Regarding claim 1, as best understood, Chen discloses a suspension system for in-line skates comprising:

a wheel support member 3A for rotatably supporting one or more wheels C1, C2 of an in-line skate of the type wherein each skate has a boot B and a plurality of wheels C1-C4 attached to the bottom of the boot B;

attaching means B1, 5 for pivotally attaching said wheel support member 3A at a pivot point to the bottom of the skate boot B and allowing said wheel support member 3A to move horizontally relative to the boot B at the pivot point; and

shock absorbing means 4 located between the boot B bottom and said wheel support member 3A for cooperating with said attaching means B1, 5 so that said shock absorbing means 4 is engaged when said wheel support member 3A pivots at the pivot point or moves relative thereto.

17. Regarding claims 2, 3, 13, and 16, as best understood, Chen discloses a suspension system wherein:

said attaching means B1, 5 allows said wheel support member 3A to move horizontally and vertically relative to the boot B at the pivot point;

said attaching means B1, 5 allows said wheel support member 3A to move at the pivot point in any direction in the vertical plane in which the wheels C1, C2 rotate;

said bottom of the boot B includes a sole plate to which said wheel support means 3A is pivotally attached by said attaching means B1, 5; and

said shock absorbing means 4 comprises compressible material.

18. Regarding claim 4, as best understood, Chen discloses an improved suspension system for in-line skates of the type wherein each skate has a boot B and plurality of wheels C1-C4 attached to the bottom of the boot B, wherein the improvement comprises:

a wheel support member 3A for rotatably supporting one or more wheels C1, C2 of an in-line skate;

attaching means B1, 5 having cooperating male 5 and female B1 portions for attaching said wheel support member 3A to the bottom of the skate boot B, said female portion B1 defining a hole B11 for receiving said male portion 5 and allowing said male portion 5 to move within the hole B11 so that said wheel support member 3A is capable of moving horizontally and vertically relative to the boot B; and

shock absorbing means 4 located between the boot B bottom and said wheel support member 3A for cooperating with said attaching means B1, 5 so that said shock absorbing means 4 is engaged when said male portion 5 moves within the hole B11 of said female portion B1.

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19. Regarding claim 18, as best understood, Chen discloses an improved in-line skate of the type having a boot B and plurality of wheels C1-C4 attached to the bottom of the boot B, wherein the improvement comprises:

a front and a rear suspension system, each of which includes:

a wheel support member 3A, 3B for rotatably supporting one or more wheels C1-2, C3-4 of the in-line skate;

attaching means B1, 5 for pivotally attaching said wheel support member 3A, 3B at a pivot point to the bottom of the boot B and allowing said wheel support member to move horizontally relative to the boot at the pivot point; and

shock absorbing means 4 located between the boot B bottom and said wheel support member 3A, 3B for cooperating with said attaching means B1, 5 so that said shock absorbing means 4 is engaged when said wheel support member pivots at the pivot point or moves horizontally relative to the boot at the pivot point.

20. Regarding claims 21-25, as best understood, Chen discloses an improved in-line skate wherein:

said front wheel support supports at least two in-line wheels;

said attaching means allows said wheel support members to move horizontally and vertically at the pivot point in the plane in which the wheels rotate;

said attaching means allows said wheel support members to move at the pivot point in any direction in the plane in which the wheels rotate.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 24 and 25, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Oliemans et al. (U.S. Patent 5,704,620), as cited by Applicant.

23. Regarding claims 24 and 25, as best understood, Chen discloses the claimed device except for the link member. Oliemans discloses that it is known in the art to provide a link member 902, 903, 906 (Figs. 9-12), 1607 (Fig. 16) pivotally connecting the front and rear wheel supports, the link member serving to keep the wheel supports aligned so that wheels attached thereto stay in alignment, and the link member permits vertical and horizontal movement of the wheel supports in the vertical plane in which the wheels rotate but restrains lateral movement of the wheel supports so that the wheel supports and wheels thereof stay in alignment. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the improved in-line skate of Chen with the link member of Oliemans, in order permit vertical and horizontal movement of the wheel supports in the plane of the wheel rotation but restrain lateral movement of the wheel supports so that the wheel supports and the wheels attached thereto stay in alignment.

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24. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Roman et al. (U.S. Patent 6,131,920).

25. Regarding claims 19 and 20, Chen discloses the claimed invention except for a brake. Roman discloses that it is known in the art to provide a brake 19 having a brake element 15, 17, the brake having first pivoting means 12 attached to the rearward end 13 of the skate boot 2 and second pivoting means 16 attached to the rear wheel support 8 (Fig. 1) and wherein the first 12 and second 16 pivoting means cooperate to 1) move the brake element into contact with the rear wheel 9 when the skater shifts his or her weight so that more weight is placed on the rear wheel support than on the front wheel support, and 2) allow the brake element 15, 17 to move in conjunction with the rear wheel support and thereby stay out of contact with the rear wheel when the skater's weight is distributed equally to the front and rear wheel supports. Roman also discloses that it is known in the art to provide brake sensitivity means 21. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the improved in-line skate of Chen with the brake of Roman, in order to brake the rotation of the wheel and slow and/or stop the in-line skate.

26. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Chang (U.S. Patent 6,012,727).

27. Regarding claim 26, Chen discloses the claimed invention except for the receiving element being provided with at least one combined vertical and horizontal slot. Chang discloses that it is known in the art to provide a receiving element with at least one combined vertical and horizontal slot 21. It would have been obvious to one having

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ordinary skill in the art at the time the invention was made to provide the receiving element of Chen with the combined vertical and horizontal slot of Chang, in order to provide easier pivotal movement of the wheel support member in the vertical and horizontal directions.

28. Claims 27, 28, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Chang as applied to claim 26 above, and further in view of Oliemans et al. (U.S. Patent 5,704,620), as cited by Applicant.

29. Regarding claims 27, 28, and 41, Chen and Chang disclose the claimed device except for the rigid link member. Oliemans discloses that it is known in the art to provide a rigid link member 902, 903, 906 (Figs. 9-12), 1607 (Fig. 16) attached by pivotable means between the bottom portions so that each wheel is capable of being moved independently to pivot the wheel support member to engage the shock absorbing means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the suspension system of Chen and Chang with the link member of Oliemans, in order allow each wheel to be capable of being moved independently to pivot the wheel support member to engage the shock absorbing means while providing lateral stability.

30. Claims 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Chang, Oliemans et al. as applied to claim 27 above, and further in view of Roman et al. (U.S. Patent 6,131,920).

31. Regarding claim 29, Chen, Chang, and Oliemans disclose the claimed invention except for a brake. Roman discloses that it is known in the art to provide a brake 19

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having a brake element 15, 17 capable of contacting one of the skate wheels 9 to brake the wheel, the brake 19 being attached to the rearward end of the skate 13 by pivotable and vertically moving means 12 (Fig. 1) and to the rear wheel support by pivotable means 16 so that the brake element 15, 17 is capable of (1) pivoting the brake element 15, 17 into contact with the rear wheel 9 when the skater shifts his or her weight so that more weight is placed on said rear wheel support than on the front wheel support, and (2) allowing the brake element 15, 17 to move vertically in conjunction with the rear wheel support and thereby stay out of contact with the rear wheel when the skater's weight is distributed equally to the front and rear wheel supports. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the suspension system of Chen, Chang, and Oliemans with the brake of Roman, in order to brake the rotation of the wheel and slow and/or stop the in-line skate.

32. Regarding claim 32, Chen, Chang, and Oliemans, and Roman disclose the claimed invention except for the brake element including a high friction material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the brake element including a high friction material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

In re Leshin, 125 USPQ 416.

Allowable Subject Matter

33. Claims 30, 31, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joselynn Y. Sliteris whose telephone number is 703-308-8225. The examiner can normally be reached on Mon-Fri 8:30 am - 6:00 pm; alternating Fri off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul N. Dickson can be reached on 703-308-2089. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2571 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1134.

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36. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 3616.

JYS 
May 3, 2002


ERIC CULBRETH
PRIMARY EXAMINER
5/6/02